

GRANT PATENT SERVICES

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To: Ms. Ethel Rollins-Cross

From: Jonathan E. Grant

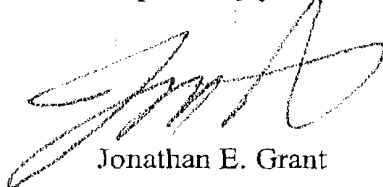
Dear Ms. Cross:

This is the case that I requested you review. I had hand delivered the response to the mail room and to your office, but somewhere during the electronic transfer, it got lost.

Here is the filing receipt and the response. I request that you review the response, as I do not believe the examiner is correct in her reading of the invention and the prior art.

Thank you.

Respectfully yours,



Jonathan E. Grant

Happy New Year

FILING Receipt

Response to 09/704,711

EXTENSION OF TIME PETITION
TRANSMITTAL Form

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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the application of:

Marlin

Serial No.: 09/704,771

Group: 3712

Filed: 11/03/2000

Examiner: Miller, B

The Honorable Commissioner of
Patents and Trademarks
Washington, D.C. 20231

AMENDMENT AND RESPONSE

Sir:

Please note that all correspondence should go to the address of the undersigned attorney, said address being:

2120 L Street, N.W.
Suite 210
Washington, D.C. 20037

This is a response to the Office Action mailed 05/22/03. The appropriate late fee and Request for Extension to File has been filed with this response. Applicant requests an interview with the examiner to discuss the above case.

RESPONSE

The Office Action of May 5, 2003 has rejected claim 22 in light of Wilson. In response,

applicant notes the following.

Claim 22 reads as follows:

22) A flexible, retractable coiled toy comprising:

a single, unitary wire having a circular cross section and having memory, said wire comprising:

- i) a helical section, said helical section ranging in length from about two and three-quarter inches to about six inches. and
- ii) a handle, said handle being integral with said helical section, said handle comprising a straight section of said wire extending outwardly from said helical section wherein said handle ranges in length from about 3 ½ inches to about 6 ½ inches.

The above described invention is not obvious in lieu of Wilson.

First, the present invention proposes an invention which is comprised of a single wire.

Wilson is comprised of a wire connected to a rubber ball and a wood handle.

The present invention is not merely a single wire, but a unitary structure, such that there are no breaks or separations in the wire; hence, the helical section and the handle are all part of the same wire. Indeed, the claim states that the handle is integral with said helical section, meaning that it was not attached but all part of the same piece.

In contrast, in Wilson, as stated above has a coil to connect a separate (rubber) ball with a wooden paddle.

Additionally, the present invention claims a handle being integral with said helical section, said handle comprising a straight section of said wire extending outwardly from said helical section wherein said handle ranges in length from about 3 ½ inches to about 6 ½ inches.

In contrast, Starr discloses a paddle ball having a wooden handle. The paddle ball taught by Starr comprises three parts (a spring, a ball, and a paddle), as opposed to the invention of the present invention. The handle referred to in 22 of the patent is the wooden paddle. The coil spring 24 does not have a handle. There is no straight section of the coil material to form a handle.

Starr's patent does not allow for its use as a lasso to capture items, as a clothing ornament, as a toy to manipulate, etc. Starr's patent is simply for a paddle ball toy.

The differences between what is taught in Wilson and the present invention is evidenced by what is shown in the videotape. The various lasso tricks, and other uses of the present invention, can not be performed or achieved by Wilson.

In ascertaining the differences between the prior art and the claims at issue (the second factual inquiry of *Graham v. John Deere*), it is essential to view the claims at issue as "the invention as a whole," as required by 103 and "without the benefit of hindsight vision afforded by the claimed invention." *Hodosh v. Block Drug Co., Inc.* 786 F.2d 1136, 1143 n. 5, 229 USPQ 182, 187 n. 5 (Fed. Cir. 1986). Similarly, it is essential to consider all elements of the claimed invention; it is impermissible to compare the prior art with what the viewer interprets the "gist" of the invention to be. *Perkin-Elmer Corp. v. Computervision Corp.*, 732 F.2d 888, 221 USPQ 669 (Fed. Cir. 1984). In *Jones v. Hardy*, 727 F.2d 1524, 1527-28, 220 USPQ 1021, 1024 Fed. Cir. 1984), the court held that reducing a claimed invention to an 'idea' and then determining patentability of the 'idea' is error.

The Office Action of the present invention is in fact using hindsight to see the present

invention from the prior art.

The application is now in condition for allowance. Please call or fax me at (301) 603-9071 if you have any questions or comments.

Respectfully submitted,

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